

## **REMARKS**

Claims 88, 89, 92, 93, 95-99, 104-109 are pending in this application. Claims 88 and 109 are currently amended. After amendment, claims 88, 92, 93, 95-99 and 104-109 are pending. No new matter is added by the foregoing amendments. Thus, entering of the foregoing amendments and reconsideration of this application in view of the current amendments and following remarks are respectfully requested.

### **Priority**

In the Office Action dated June 2, 2004, the Examiner maintained that the pending claims are not entitled to a priority date of November 18, 1999 because the provisional application no. 60/166,381 does not mention the discovery of peptide compounds that upregulate glutathione peroxidase. The Examiner then stated that the priority date should be the filing date of November 17, 2000.

Applicant respectfully disagrees. The compounds described in the provisional application no. 60/166,381 are able to upregulate glutathione peroxidase. However, in order to expedite the prosecution and without conceding the correctness of the Examiner's statements, applicant amended claims 88 and 109. As pointed out by the Examiner, the provisional application no 60/166,381 discloses the peptide compounds stimulate expression of superoxide dismutase (SOD) and catalase (CAT). *See* 6/2/2004 Office Action, pp. 2-3. Thus, applicant respectfully submits that the priority date should be November 18, 1999, the filing date of the provisional application no. 60/166,381.

### **Claim Objections**

The Examiner objected to claims 88 and 109 for typographical errors. Applicant respectfully submits that the Examiner's objection to informalities in claims 88 and 109 is obviated by this amendment.

### **Claim Rejections Under 35 U.S.C. §103(a)**

The Examiner maintained rejections of claims 88, 92, 93, 95-99, 104-106, 108 and 109 as being obvious under 35 U.S.C. § 103 over U.S. Patent No. 6,627,601 (“Shashoua, V”), in view of Jornot et al. Biochem. J. 326: 117-123 (1997), and U.S. Patent No. 5,972,985 (“Thomas”). Shashoua, V. teaches the method of increasing neuronal activator protein (AP-1) transcription factor comprising administering an isolated polypeptide. Jornot et al. teaches the upregulation of glutathione peroxidase due to presence of tumor promoting agent responsive elements (TREs). Thomas teach nutraceutical compositions that contain a plant source useful as a dietary supplement which have antioxidant properties. Applicant respectfully traverses.

Attached herein as Exhibit A, applicant respectfully submits a declaration by Dr. Victor E. Shashoua made pursuant to 37 CFR 1.132. In this declaration, Dr. Victor E. Shashoua states that he is the sole inventor of the instant application and he is also the sole inventor of Shashoua, V., the primary reference cited by the Examiner in rejecting the pending claims.

Shashoua, V. is not a prior art under 35 U.S.C. §102(a). 35 U.S.C. §102(a) requires the invention to be “known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” Shashoua V. was issued on September 30, 2003 and its PCT counterpart (WO 01/36454) was published on October 25, 2001. Both dates are after the priority date of the instant application. Thus, Shashoua V. is not a prior art under 35 U.S.C. §102(a). *See also* M.P.E.P. 2132, III.

Shashoua, V. is not a prior art under 35 U.S.C. §102(b). 35 U.S.C. §102(b) requires the invention to be “patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” As described above, Shashoua V. was issued on September 30, 2003 and its PCT counterpart (WO 01/36454) was published on October 25, 2001. Both dates are after the priority date of the instant application. Thus, Shashoua V. is not a prior art under 35 U.S.C. §102(b). *See also* M.P.E.P. 2133.

Shashoua, V. is not a prior art under 35 U.S.C. §102(c). 35 U.S.C. §102(c) relates to abandonment of an invention. Dr. Victor E. Shashoua did not abandon the instant application. *See also* M.P.E.P. 2134.

Shashoua, V. is not a prior art under 35 U.S.C. §102(d). 35 U.S.C. §102(d) requires the invention to be “first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.” Shashoua V. was issued on September 30, 2003 and its PCT counterpart (WO 01/36454) was published on October 25, 2001. Both dates are after the priority date of the instant application. Thus, Shashoua V. is not a prior art under 35 U.S.C. §102(d). *See also* M.P.E.P. 2135.

Shashoua, V. is not a prior art under 35 U.S.C. §102(e). 35 U.S.C. §102(e) requires the invention to be “described in an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent ...; or a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent...” (emphasis added). As stated in the attached declaration, Shashoua V. and the instant application are by the same inventor, Dr. Victor E. Shashoua. Thus, Shashoua V. is not a prior art under 35 U.S.C. §102(e). *See also* M.P.E.P. 2136.04.

Shashoua, V. is not a prior art under 35 U.S.C. §102(f). 35 U.S.C. §102(f) provides that a person shall not be entitled to a patent if “he did not himself invent the subject matter sought to be patented.” The invention described in the instant application was invented by Dr. Victor E. Shashoua. *See also* M.P.E.P. 2137.

Shashoua, V is not a prior art under 35 U.S.C. §102(g). 35 U.S.C. §102(g) relates to interference between two different inventors. As stated in the declaration, the instant application is by the same inventor as Shashoua V. Thus, Shashoua, V is not a prior art under 35 U.S.C. §102(g). *See also* M.P.E.P. 2138.

Shashoua, V is not a prior art under 35 U.S.C. 103(a). According to M.P.E.P. 2141.01, “[b]efore answering Graham’s content inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. 102 .... and [a] 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date.” As described above, Shashoua, V is not a prior art under 35 U.S.C. 102.

Furthermore, information described in Shashoua, V was not available to the public until the patent issuance date of September 30, 2003 or the publication date (October 25, 2001) of its

PCT counterpart (WO 01/36454). Both dates are after the priority date of the instant application. Thus, information described in Shashoua, V does not represent the general knowledge of the public at the priority date of the instant application.

Thus, applicant respectfully submits that Shashoua, V is not qualified as a prior art under 35 U.S.C. §103(a) as referenced by the Examiner. *See* M.P.E.P. 2144.08, II.A.1 (“As an initial matter, Office personnel should determine the scope and content of the relevant prior art. Each reference must qualify as prior art under 35 U.S.C. 102).

Without Shashoua, V as a prior art, Jornot et al describes upregulation of glutathione peroxidase due to the presence of tumor promoting agent responsive elements (TREs), which are the binding sites for the transcription factor activator protein-1 (AP-1). But Jornot et al. does not describe the use of any peptide compound to upregulate the activities of glutathione peroxidase. Neither does Jornot et al. provide any teachings as to how to find a peptide compound capable of preventing or eliminating reactive oxygen species and free radicals. Thus, Jornot et al does not make the invention described in the instant application obvious.

In the absence of Shashoua, V, Thomas describes nutraceutical compositions useful as a dietary supplement which may function as antioxidant/free radical scavengers and which may also have a cytoprotective effect. Thomas does not teach the use of a peptide compound to eliminate or prevent reactive oxygen species or free radicals. Thus, the invention described in the instant application will not be obvious for a person skilled in the art in light of Thomas.

Thus, applicant traverses the Examiner’s rejection of claims 88, 92, 93, 95-99, 104-106, 108 and 109 and respectfully requests the rejection to be withdrawn.

### **Conclusion**

Applicant believes that he has fully responded to the Examiner’s concerns and that each of the claims is in condition for allowance. Applicant respectfully requests reconsideration and allowance of all pending claims.

No fee is required by this amendment. However, in the event that any fee is required, the Commissioner is hereby authorized to charge such fees, which may be required, or to credit any overpayment, to Deposit Account No. 02-4270.

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

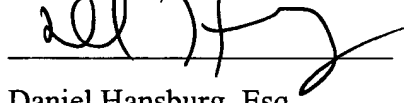
Applicant respectfully submits this Information Disclosure Statement pursuant to 37 C.F.R. §§ 1.97 and 1.98. Enclosed are an Information Disclosure Citation List and a copy of each document listed therein, The Examiner is respectfully requested to consider the enclosed documents, make them of record, and indicate her consideration of the documents by initialing the enclosed Citation List adjacent the citation of each document. Please return a copy of the initialed Citation List to Applicant's undersigned attorney.

A fee of \$180 is required pursuant to 37 C.F.R. §§ 1.97(c) & 1.17(p). The Commissioner is hereby authorized to charge such fees, as well as any additional fee, which may be required, to the Deposit Account 02-4270.

In the event that the Examiner has any further concerns, applicant requests a call to be made to Applicant's attorney at the number listed below.

Dated: 2 August 2004

Respectfully submitted,



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